

REMARKS

Favorable reconsideration of this application, in light of the preceding amendments and following remarks, is respectfully requested.

Claims 1, 2, 6, and 9-24 are pending in this application. By this Amendment, claim 1 is amended; and claims 22-24 are added. No new matter is added. Claims 1, 15, and 19 are the independent claims.

Applicant notes with appreciation the Examiner's acknowledgement that certified copies of all priority documents have been received by the U.S.P.T.O.

Applicant also respectfully notes the present action indicates that the drawings have been accepted by the Examiner.

Applicant's Traversal of Restriction Requirement

In the outstanding Office Action, the Examiner withdrew claims 15-21 as being directed to a non-elected invention, and failed to explicitly address Applicant's comments regarding the traversal of the Restriction Requirement in the Response mailed February 24, 2010.

Specifically, it is respectfully submitted that the Examiner has not carried forward the burden of proof to establish "distinctness" since all claims are directed to a process for assembling at least one electronic component on a substrate.

Moreover, Applicant respectfully notes that MPEP § 803 states:

[i]f the search and examination of an entire application can be made without serious burden, the Examiner must examine it on the merits, even though it includes claims to distinct or independent inventions. (*emphasis added*)

Accordingly, due to the fact that the Examiner has already considered the claims and conducted a search in previous Office Actions of February 14, 2008, August 19, 2008, February 4, 2009, and November 24, 2009, it is unclear how there is a "serious burden" on the Examiner to continue examining claims which have already been searched. Further, Applicant respectfully submits that claims 15-21 appear to be part of an overlapping search area. Applicant also respectfully notes that independent claims 15 and 19 include features somewhat similar to independent claim 1.

In view of the above, reconsideration and withdrawal of the Restriction Requirement, and favorable allowance of all claims in the instant application are earnestly solicited.

Claim Rejections - 35 U.S.C. § 103

Claims 1, 2 and 9 are rejected under 35 U.S.C. § 103(a) as being unpatentable over DE 19645083 A1 (hereinafter "Prancz"). Applicant respectfully traverses this rejection for the reasons discussed below.

In order to establish a *prima facie* case of obviousness under 35 U.S.C. § 103(a), all of the claim limitations of the rejected claims must be described or suggested by the cited document(s).¹ Applicant respectfully submits that the cited documents do not meet this criterion, because no modification of the Prancz reference will describe or suggest all of the claim limitations of rejected claims 1, 2, and 9, and therefore, a *prima facie* case of obviousness has not been established.

For example, claim 1, as amended, recites, *inter alia*:

the conductive areas of the electronic component and the conductive tracks of the substrate are in contact to achieve a **permanent** electric connection via a pressure of application of the insulating material layer on the electronic component, and after forming the layer of insulating material. (*emphasis added*)

Applicant respectfully submits that the Prancz reference does not disclose or suggest that the electrical connection of the conductive areas of the electronic component and the conductive tracks of the substrate is "permanent."

In the outstanding Office Action, the rejection is based on an assertion that the contact surface 10 of Prancz corresponds to the "conductive tracks" and the chip module 7 of Prancz corresponds to the "electronic component."² Although Applicant submits that the contact surface 10 and chip module 7 of Prancz may correspond to the conductive tracks and electronic component, respectfully, it is submitted that the contact surface 10 and chip module 7 are not in a "permanent" connection.

In other words, the chip module 7 (via contacts) and the contact surface 10 (via pads) of the coil are connected through a "switching element" 6 placed between the chip contacts and the pads. This switching element 6 is made up of pressure sensitive conductive rubber mats, which connect the elements together only if a pressure is applied voluntarily on the chip card at both faces of the chip location (see FIG. 1). When the pressure is released, the connection is interrupted (not in contact) and the chip card deactivated – see, e.g., pages 8, 9, 12, and 13 of the English translation of Prancz document, describing in detail the contact on/off switching function of the pressure sensitive element 6.

¹ See *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). See also MPEP § 2143.03.

² See Office action mailed April 28, 2011, pages 2 and 3.

Further, one skilled in the art would not attempt to modify Prancz to arrive at the features as taught by claim 1 since mechanical constraints exerted on the chip card of Prancz may switch the ON or OFF connection in a non-controlled manner. Thus, one skilled in the art will appreciate that one would not include a pressure sensitive element to achieve a stable and secure connection.

Moreover, since Prancz does not disclose the “permanent” connection, it cannot teach or suggest the feature of “the contacted conductive areas of the electronic component and the conductive tracks of the substrate are configured to rub together when repeated stressed are exerted on the substrate,” as taught by claim 1.

Therefore, Applicant respectfully submits that the device of Prancz fails to disclose or suggest the conductive areas of the electronic component and the conductive tracks of the substrate are in contact to achieve a permanent electric connection, as recited in claim 1.

Further, Applicant respectfully submits that Prancz fails to disclose or suggest “forming a layer of insulating material which extends concurrently on the electronic component and at least on the zone of the substrate surrounding said electronic component,” as recited by claim 1.

In the outstanding Office Action, the rejection is based on an assertion that the switching element 6 of Prancz corresponds to a “layer of insulating material.”³ Applicant respectfully disagrees.

Firstly, element 6 in Prancz is merely a “switching element” to connect the chip contacts and the pads together. It is not a “layer of insulating material.”

³ See Office action mailed April 28, 2011, page 3.

Secondly, even assuming *arguendo* that the switching element is a “layer of insulating material” (which Applicant does not agree or admit), the switching element does not extend concurrently on the electronic component and the zone of the substrate surrounding said electronic component. As clearly shown in FIG. 1 of Prancz, the switching element 6 is placed “between” the chip module 7 and the coil.

Therefore, Prancz fails to disclose or suggest “forming a layer of insulating material which extends concurrently on the electronic component and at least on a zone of the substrate surrounding said electronic component,” as recited by claim 1.

Finally, Applicant respectfully submits that Prancz fails to disclose or suggest “... the conductive areas of the electronic component coming into contact with the corresponding conductive tracks of the substrate,” as recited by claim 1.

In the outstanding Office Action, the rejection is based on an assertion that the area of contact area 9 in Prancz corresponds to the “conductive areas.”⁴ Applicant respectfully disagrees because the contact area 9 is not in contact with any corresponding conductive tracks of the substrate. Instead, contact area 9 is in contact with only the contacts of the chip module 7 or the contact surface 10 – see FIG. 1.

Therefore, Prancz fails to disclose or suggest “the conductive areas of the electronic component coming into contact with the corresponding conductive tracks of the substrate,” as recited by claim 1.

Since the rejection fails to disclose or suggest each and every element of the rejected claims, Applicants respectfully submit that no *prima facie* case of obviousness has been established with respect to claim 1.

⁴ See Office action mailed April 28, 2011, page 3, first paragraph.

In view of the above, Applicant respectfully submits that the Prancz reference fails to teach or suggest each and every element of claim 1, and therefore, claim 1 is allowable over the cited prior art. Claims 2 and 9 are dependent from claim 1, and therefore, also allowable. Accordingly, Applicant respectfully requests that the rejection under 35 U.S.C. § 103(a) be reconsidered and withdrawn.

Claim 6 is rejected under 35 U.S.C. § 103(a) as being unpatentable over DE 19645083 A1 in view of JP 01020197 A to Ikeda ("the Ikeda reference"). Applicant respectfully traverses this rejection for the reasons discussed below.

Claim 6 is believed to be allowable for at least the reasons set forth above regarding claim 1. The Ikeda reference fails to provide the teachings noted above as missing from the Prancz reference. Since claim 6 is patentable at least by virtue of its dependency on claim 1, Applicant respectfully requests that the rejection of claim 6 under 35 U.S.C. § 103(a) be withdrawn.

NEW CLAIMS

Claims 22-24 have been added in an effort to provide further, different protection for Applicant's invention. Claims 22-24 are allowable at least for the reasons somewhat similar to those given for claim 1, and/or for the further features recited therein. For instance:

- o claim 22 recites that the conductive areas of the electronic component and the conductive tracks of the substrate are in direct contact to obtain the permanent electric connection;

- o claim 23 recites that the conductive areas of the electronic component and the conductive tracks of the substrate are in constant contact to obtain the permanent electric connection; and
- o claim 24 recites the layer of insulating material extends concurrently over the electronic component and the zone of the substrate surrounding the electronic component.

Support for claims 22-24 may be found in at least FIGS 1 and 2. No new matter is added.

CONCLUSION

In view of the above remarks and amendments, Applicant respectfully submits that each of the pending objections and rejections has been addressed and overcome, placing the present application in condition for allowance. A notice to that effect is respectfully requested. Further, the above remarks demonstrate the failings of the outstanding rejections, and are sufficient to overcome the rejections. However, these remarks are not intended to, nor need they, comprehensively address each and every reason for the patentability of the claimed subject matter over the applied prior art. Accordingly, Applicant does not contend that the claims are patentable solely on the basis of the particular claim elements discussed above.

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact the undersigned, at the telephone number below.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No.

08-0750 for any additional fees required under 37 C.F.R. § 1.16 or under 37 C.F.R. § 1.17; particularly, extension of time fees.

Respectfully submitted,

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